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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,086	09/19/2001	Tomohiko Ishikura	040679-1364	9777

22428 7590 02/14/2005

FOLEY AND LARDNER  
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WASHINGTON, DC 20007

EXAMINER
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FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/955,086

Applicant(s)

ISHIKURA, TOMOHIKO

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicant's amendment filed November 29, 2004 is acknowledged. Accordingly, claims 1-10, 12, and 13 remain pending.
2. All references in this Office Action (this "First Final Office Action") to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in office action(s) refers to the Examiner of record while reference to or use of the lower case version of "examiner" refers to examiner(s) generally.
3. This First Final Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

### ***Claim Rejections - 35 USC §102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12, and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by Snellen (U.S. 5,430,831). Snellen discloses a first unit that measures a position of each load (the second, devices measure the dimensions of the respective objects to be placed in a space); a server (the computer) which determines absolute physical position (the computer calculates the

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actual size of the object) relative to a logical position (0,0,0); and a second unit that determines absolute physical position (calculates the actual position including the object dimensions from 0,0,0); the logical position (0,0,0) is available for inventory control (inherent) and is given by three units.

6. Claims 1-10, 12, and 13 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Guthrie (U.S. 5,565,858).

***Claim Rejections - 35 USC §103***

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over DD in view of Snellen in view of Shames's Engineering Mechanics, Statics and Dynamics 3<sup>rd</sup> Ed. ("Shames").<sup>1</sup> It is the Examiner's principle position that the claims 12 and 13 are anticipated because the second unit inherently develops the relative logical position is inherent in Snellen.

However if not inherent, Shames discloses the use of position vectors and how such vectors are translated to various points of reference, the least of which is a 0,0,0 reference. It therefore would have been obvious to a person having ordinary skill in the art at the time the

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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invention was made to modify Snellen as taught by Shames to include the second unit developing the relative logical position.

9. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>2</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second and with the exception of “server” which will be discussed below, the Examiner finds that not only has Applicant not pointed to any other definitional statement(s) found in his specification or prosecution history, Applicant has also not pointed to any other term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and precision.<sup>4</sup> Third, after receiving express notice in the First Non Final Office Action of the Examiner’s position that lexicography is not invoked,<sup>5</sup> Applicant has not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance

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<sup>2</sup> See the Examiner’s previous Office Action mailed June 29, 2004 (“First Non Final Office Action”), Paragraph No. 7.

<sup>3</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> “The patentee’s lexicography must, of course, appear ‘with reasonable clarity, deliberateness, and precision’ before it can affect the claim.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See again the Examiner’s First Non Final Office Action, Paragraph No. 7.

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with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>6</sup> to be his own lexicographer.<sup>7</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>8</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>9</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

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<sup>6</sup> *Id.*

<sup>7</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed February 10, 2005).

<sup>8</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>9</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"

***Response to Arguments***

10. Applicant's arguments filed November 29, 2004 have been fully considered but they are not persuasive.

11. Applicant's comments with respect to paragraph no. 7 (of the First Non Final Office Action) on page 5 of his response is acknowledged. Applicant's comments regarding *Philips v. AWH Corp.* is also acknowledged. While the Examiner respectfully disagrees since *Phillips* concerns inter partes litigation while the Examiner's concern is with ex parte examination, Applicant's response is noted for the record.

12. Applicant also argues "that the term 'server' is defined in the specification as a machine (including program) that is connected to a network to receive data from a client."<sup>10</sup> The Examiner has again carefully review the original specification and can not locate any such definition for "server" as provided by Applicant in his remarks. Applicant's attempt at being his own lexicographer is denied because Applicant has not pointed to where in his specification the definition is found. The Examiner finds that the attempted lexicographic definition is clearly provided *after* the filing date of the application. Because the only evidence to support Applicant's proffered definition is filed *after* the filing date of the application, the definition constitutes new matter. Because Applicant is not his own lexicographer, the claims continue to be interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1054, 44 USPQ2d 1027.

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<sup>10</sup> Applicant's Response filed November 29, 2004, Page 5, ¶4.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

15. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR



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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

17. Because this application is now final, Applicant(s) are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

18. Also in accordance with *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35, the Examiner finds that the reference Engineering Mechanics, Statics and Dynamics, 3<sup>rd</sup> Ed., by Iving H. Shames is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that Shames illustrates various fundamental ideas underlying engineering mechanics such as the concepts of dimensions, units, and vector algebra.

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The student text also provides a brief discussion of the basic laws of mechanics and the tools used in the practical application of those laws. The reference is cited in its entirety. Moreover, because the reference is a introductory textbook that presupposes no prior knowledge of engineering mechanics, because of the reference's basic content which is self evident upon review of the reference, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that Shames is primarily directed towards those of low skill in this art. Because Shames is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Shames.

19. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>11</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the

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Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
February 10, 2005

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<sup>11</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.